

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF PUERTO RICO

1 BAYER AG, et al.,  
2

3 Plaintiffs

4 CIVIL NO. 98-1282 (RLA)  
5 CIVIL NO. 98-1340 (RLA)  
6 v. CIVIL NO. 98-1494 (RLA)  
7 CIVIL NO. 98-1768 (RLA)

8 BIOVAIL LABORATORIES, INC.,  
9 et al.,

10 Defendants.

11 ORDER DENYING MOTION TO COMPEL

12 The Court having reviewed the arguments submitted by the  
13 parties as well as the transcript of the deposition of MS. DINA  
14 KHAIRO, employee of BIOVAIL CORP. INTERNATIONAL, hereby finds that  
15 the attorney-client privilege was properly raised by counsel.

16 The objections were limited to those particular questions which  
17 required the deponent to fully disclose the substance of  
18 communications exchanged during meetings in which defendant's  
19 counsel were present and their legal advise was being sought. The  
20 fact that the role of the attorneys during those meetings was in  
21 connection with preparation of the ANDAs and that technical  
22 information was involved does not detract from the fact that counsel  
23 were there as experts in the law and to render services in that  
24 capacity. Therefore, communications between the client and counsel  
25 within this context are not subject to discovery. See Daniel A.  
26 DeVito & Michael P. Dierks, *Exploring Anew the Attorney-Client*

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5 Page 2

6 *Privilege and Work-Product Doctrine in Patent Litigation: The*  
 7 *Pendulum Swings Again, This Time in Favor of Protection*, 22 AIPLA  
 8 *Q.J.*, 103 (Spring, 1994). See also Paul R. Rice, *Attorney-Client*  
 9 *Privilege: Continuing Confusion about Attorney Communications,*  
 10 *Drafts, Pre-Existing Documents, and the Source of the Facts*  
 11 *Communicated*, 48 American Univ. L. Rev., 967, 1005 n.67 (1999);  
 12 Grace M. Giesel, *The Legal Advice Requirement of the Attorney-Client*  
 13 *Privilege: A Special Problem for In-House Counsel and Outside*  
 14 *Attorneys Representing Corporations*, 48 Mercer L. Rev. 1169, 1214  
 15 (Spring 1997).

16 Based on the foregoing, Plaintiffs Bayer AG, Bayer Corporation  
 17 and Pfizer Inc.'s Brief in Support of Motion to Compel Discovery,  
 18 filed on January 7, 2000 (docket No. 66)<sup>1</sup> is DENIED.

19 This Order shall be notified by FAX and mail.

20 IT IS SO ORDERED.

21 San Juan, Puerto Rico, this 20<sup>th</sup> day of January, 2000.

22   
 23 RAYMOND L. ACOSTA  
 24 United States District Judge

25 <sup>1</sup> See Response, filed by defendants on January 18, 2000  
 26 (docket No. 68).